

TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
ELRP:101_US_

In Re Application of Mancuso et al.

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/954,766	09/18/2001	John Quoc Nguyen	24041	3654	8533

Title: **COIL REEL HOLD-DOWN DEVICE**

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/C. Paul Maliszewski/

Dated: August 2, 2007

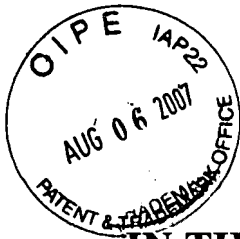
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U.S. Patent Application 09/954,766
Attorney Docket No.: ELRP:101_US_

**IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE**

Appellants: **MANCUSO, Anthony J. et al.**

Examiner: **Nguyen, John Quoc**

U.S. Patent Application No.: **09/954,766**

Group Art Unit: **3654**

For: **COIL REEL HOLD-DOWN DEVICE**

Filed: **September 18, 2001**

Customer No. **24041**

Confirmation No. **8533**

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

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Honorable Sir:

This Reply Brief is in reply to the Examiner's Answer dated June 18, 2007.

Serial No. 09/954,766
Attorney Docket No. ELRP:101_US_
Reply Brief dated August 2, 2007

STATUS OF CLAIMS

The application originally contained 12 claims.

Claims 6-8 have been cancelled.

Claims 1-5 and 9-12 stand as finally rejected.

Claims 1-5 and 9-12 are the subject of this Appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claim 6 is indefinite under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Appellants regards as the invention?
2. Whether Claims 1-6 and 9-11 are novel under 35 U.S.C. § 102(b) and therefore patentable over Welp et al. (USPN 5,518,199)?
3. Whether Claims 7, 8, and 12 are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over Welp et al. (USPN 5,518,199)?

ARGUMENT

1. Whether Claim 6 is indefinite under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Appellants regards as the invention?

A.) Summary of the Rejection: In the May 12, 2005 Final Office Action (hereinafter referred to as the Office Action) the Examiner rejected Claim 6 as indefinite under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Appellants regards as the invention. The Examiner stated: "Claim 6 recites the limitation "means for effecting a pivoting movement". There is insufficient antecedent basis for this limitation in the claim."

B.) The References cited by The Examiner: The Examiner cited 35 U.S.C. § 112, second paragraph, which states: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention."

C.) Arguments

Appellants have cancelled Claim 6 in the attached amendment under 37 CFR 41.33(b)(1). Therefore, Claim 6 has been removed from consideration and the rejection is rendered moot and will not be addressed further.

2. Whether Claims 1-6 and 9-11 are novel under 35 U.S.C. § 102(b) and therefore patentable over Welp et al. (USPN 5,518,199)?

A.) Summary of the Rejection: In the Office Action, the Examiner rejected Claims 1-6 and 9-11 under 35 U.S.C. §102(b) as being anticipated by Welp et al. (USPN 5,518,199). The Examiner stated: "Note the coil reel hold-down device comprising arm 13 having first and second sections as claimed. The arm is pivoted to the "base plate" 11 secured to a floor via member 9 and the frame of the machine and being moved by a cylinder device to engage wheel/roll 15 with the roll 3. The angle between the first and second sections of arm 13 is about 120 degrees." The specific basis for this rejection appears to be "Fig. 1."

B.) The References cited by The Examiner: For purposes of providing background, Appellants briefly discusses the references cited by the Examiner.

1.) Welp: (Appellants have assigned numerical designators when possible, however, this was not always possible due to inconsistencies in the nomenclature used by Welp) Elongated support roller 5 is centered on and rotatable about horizontal axis A and radially engages at least one row of takeup rolls 3 coaxial to a takeup-roll axis parallel to support-roller axis A and including at least one central roll and a pair of end rolls axially flanking the central roll. A paper web 1 is fed to the support roller and passes through cutting device 6 between the web supply and the support roller for slitting the web into a plurality of strips including at least one central strip and a pair of end strips flanking the end strip. The central and end strips pass at least partially around the support roller and are wound on the respective central and end rolls. The support roller is rotated about its axis so that the strips wind at least partially around the support roller and at least the central roll is rotated by engagement with the support roll. Respective end-roll periphery drives 17 and 18 radially engage the end rolls for rotating same at a greater peripheral speed than the support roller.

C.) Arguments

In the Examiner's Answer, the Examiner has stated the Examiner does not agree with the Appellants as shown in item (10) of the Examiner's Answer. Appellants respectfully resubmit all of the arguments presented in the above-mentioned Appeal Brief and in the interest of brevity do not repeat these arguments here. These arguments are supplemented as follows. Appellants further traverse all arguments made by the Examiner not explicitly acknowledged here below.

1.) Welp does not teach a floor.

Claim 1 recites: "a base plate operatively arranged to be secured to a *floor* (emphasis added);" The Examiner stated: "since all elements and structures shown in figure 1 cooperate with each other to perform the winding operation, their locations and positions relative to each other have to be fixed as shown and, therefore, would necessitate that all the elements and structures be ultimately secured to a fixed common reference structure such as a floor, and (4) the apparatus is clearly not floating in mid-air and there is no such suggestion in Welp et al."

Figure 1 of Welp and the description of Figure 1 in the specification do not show or describe a floor. According to MPEP 608.02.IX (specifically, page 600-99), the cross-hatched areas shown in Figure 1 are metal. See the example in the upper left hand corner of page 600-99. Given the shape of the cross-hatched area and its metallic composition, there is no basis for assuming that Welp intended (but did not mention anywhere in the specification) the cross-hatched areas to be a floor.

Welp is silent regarding the support structure associated with his invention. For example, Welp's device could be designed to be part of another, larger machine/structure or to be supported by beams over a pit or by an overhead support structure.

2.) Welp does not teach securing his machine to a floor

The Examiner has stated that base plate 11 (actually slide 11 in Welp) is secured to the floor via member (traverse in Welp) 9 and the framework of the machine. Appellants have shown that Welp does not teach a framework. However, assuming *arguendo* that Welp does teach a framework and the preceding linkage of components is correct, Welp is silent as to whether the framework is secured in any manner. Assuming *arguendo* that Welp's framework is secured to another structure, there is no teaching that the structure is a floor. Any number of arrangements could be used to secure the framework and many of the possible arrangements do not involve securing the framework to a floor. For example, Welp's machine could be supported by legs or stanchions that are not secured to a floor. Thus, there is no basis for the Examiner's assertion that Welp's framework is secured to a floor. Nor is there any inherent requirement for Welp's framework to be secured to the floor. There is any number of operational or logistical reasons for not securing Welp's device to a floor.

3.) Claim 1 recites a structural difference

The Examiner stated: "A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the base plate is deemed capable of being secured to a floor."

Appellants respectfully disagree. Appellants have shown in the arguments of record that Claim 1 recites a free-standing coil reel hold-down device. Assuming *arguendo* that Welp teaches a base plate, the base plate is structurally connected to the remainder of Welp's device. Thus, at least for this reason, Claim 1 recites a distinct structural difference between the base plate recited in Claim 1 and any alleged analogous device in Welp. Further, as shown *supra*, Welp does not teach any interface (other than a possible interface through a myriad of components) between an alleged base plate and a floor. Also, as shown *supra*, Welp does not teach any type of securement to a floor. Assuming *arguendo* that Welp teaches any securement to a floor, which is not the case, Welp cannot secure an alleged base plate to a floor because of the myriad of intermediate parts between the base plate and the floor.

Thus, there is a very distinct structural difference in the invention recited in Claim 1 and Welp. That is, the base plate of Claim 1 is free-standing and securable to a floor and an alleged base plate in Welp's machine is integral to the machine and not securable to a floor.

4.) Welp is not capable of performing the intended use

Further, Welp is not capable of performing the intended use. That is, assuming *arguendo* that Welp teaches a base plate, Welp cannot and does not teach a free-standing base plate capable of being connected to a floor. As noted *supra*, Welp only teaches connecting an integral alleged base plate to a myriad of intermediate structures and provides no teachings as to if or how the intermediate structures are secured.

5.) The Examiner is reaching with respect to the definition of "secured."

The Examiner stated: "Furthermore, the limitation "operatively arranged to be secured to a floor" (claim 1, line 2) is open-ended in that it can include an infinite number of elements in making the base plate capable of being secured to a floor, contrary to appellant's arguments. In other words, the limitation does not preclude the presence of other elements in between the base plate and the floor."

Appellants respectfully submit that the Examiner has applied an overly broad and ultimately meaningless interpretation of the Claim 1 recitation of: "a base plate operatively arranged to be

secured to a floor;" Appellants' arguments are of record and in the interest of brevity are not repeated.

6.) Welp does not inherently teach the elements of Claim 1

The Examiner stated: "As noted in the rejection above, it is deemed inherent that there is ultimately a floor to which the apparatus is secured because (1) since the snubber arm 13 is used to apply a force against the roll 3, the apparatus including the base plate supporting the snubber arm has to be ultimately secured to a floor (just like in appellant's invention), otherwise the snubber arm would not be able to apply a force against the roll 3, it would just tilt instead,"

Assuming *arguendo* that Welp teaches the other limitations of Claim 1, which is not true, Appellants have shown *supra* that there is no explicit or inherent teaching that Welp teaches securing any part of his apparatus to a floor. There is no requirement for securing Welp's device to a floor for the operation of the snubber. For example, if Welp's device is suspended by overhead components or resting on a support structure, the inertial mass of the device could be sufficient to react the force of the snubber.

The Examiner further stated: "(2) the apparatus is a winding machine, the rotational inertia of the rotating rolls 3 necessitate that the apparatus be secured to a floor, (3) since all elements and structures shown in figure 1 cooperate with each other to perform the winding operation, their locations and positions relative to each other have to be fixed as shown and, therefore, would necessitate that all the elements and structures be ultimately secured to a fixed common reference structure such as a floor, and (4) the apparatus is clearly not floating in mid-air and there is no such suggestion in Welp et al."

Again, there is no requirement to secure Welp's machine to a fixed common reference. There is no reason to assume that Welp's machine, resting on stanchions for example, would be unable to react the rotational inertia of the rolls. Further, there is no reason that the relative fixing of Welp's components requires securing Welp's machine to a floor. For example, the mass or inertia of Welp's machine could provide ample reaction for any forces generated by the operation of Welp's machine without the requirement of securing the machine to a reference structure such as a floor.

Appellants have shown *supra* that Welp does not expressly teach a floor, securing a slide to a framework, or securing his device to a floor. Nor do a floor, securing a slide to a framework, or securing his device to a floor necessarily flow from the teachings of Welp. As noted *supra*, Welp's device can be secured to structural elements other than a floor, for example, beams over a pit, or can be "unsecured" with respect to a structural element. For example, the device can be supported by stanchions resting, but not connected to, a floor. Nor does the Examiner's definition of "secure" necessarily flow from the teachings of Welp.

7.) Welp's framework

The Examiner stated: "It should be noted that the frame (see figure above) also sits on structures to the right of the cross-hatched element of Welp et al. Furthermore, since the frame is not shown cross-hatched, it is therefore not in the same vertical plane as the cross-hatched element and it may or may not sit on the cross-hatched element at all."

Applicants have shown in the arguments of record that the Welp does not teach a framework. Therefore, the "framework" referenced by the Examiner is undefined and has no meaning. However, assuming *arguendo* that Welp does teach a framework and the preceding linkage of components is correct, Welp is silent as to whether the framework is secured in any manner. The above argument by the Examiner fails to point to any explicit or inherent teaching regarding securing an alleged base plate to a floor.

3. Whether Claims 7, 8, and 12 are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over Welp et al. (USPN 5,518,199)?

A.) Summary of the Rejection: In the Office Action, the Examiner rejected Claims 7, 8, and 12 under 35 U.S.C. §103(a) as being unpatentable over Welp et al. (USPN 5,518,199). In the Office Action and in an Office Action dated December 15, 2004, the Examiner stated: "The particular type of cylinder used to pivot the arm of Welp et al and the particular angular range of movement of the arm would have been obvious design considerations to one of ordinary skill for reasons presented previously in the prosecution of the application."

B.) The References cited by The Examiner: For purposes of providing background, Appellants briefly discusses the references cited by the Examiner.

1.) Welp: (Appellants have assigned numerical designators when possible, however, this was not always possible due to inconsistencies in the nomenclature used by Welp) Elongated support roller 5 is centered on and rotatable about horizontal axis A and radially engages at least one row of takeup rolls 3 coaxial to a takeup-roll axis parallel to support-roller axis A and including at least one central roll and a pair of end rolls axially flanking the central roll. A paper web 1 is fed to the support roller and passes through cutting device 6 between the web supply and the support roller for slitting the web into a plurality of strips including at least one central strip and a pair of end strips flanking the end strip. The central and end strips pass at least partially around the support roller and are wound on the respective central and end rolls. The support roller is rotated about its axis so that the strips wind at least partially around the support roller and at least the central roll is rotated by engagement with the support roll. Respective end-roll periphery drives 17 and 18 radially engage the end rolls for rotating same at a greater peripheral speed than the support roller.

C.) Arguments

Appellants have cancelled Claims 7 and 8 in an amendment under 37 CFR 41.33(b)(1) filed April 20, 2007. Therefore, the rejection of the foregoing claims is moot.

Appellants reaffirm the arguments of record regarding Claim 12.

Conclusion

Claim 6 has been cancelled; therefore, Claim 6 has been removed from consideration and the rejection of Claim 6 under 35 U.S.C. §112, second paragraph is rendered moot.

For the reasons set forth above, Appellants respectfully submit that Claims 1-5 and 9-11 are novel under 35 U.S.C. § 102(b) with respect to Welp et al. (USPN 5,518,199).

For the reasons set forth above, Appellants respectfully submit that Claim 12 is non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over Welp et al. (USPN 5,518,199). Claims 7 and 8 have been cancelled; therefore, Claims 7 and 8 have been removed from consideration and the rejection of Claims 7 and 8 under 35 U.S.C. §103(a) over Welp is rendered moot.

Accordingly, Appellants pray that this Honorable Board will reverse the Examiner's rejection of Claims 1-5 and 9-12.

Respectfully submitted,

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Dated: August 2, 2007
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